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LEWIS AND ROCA LLP 1663 Hwy 395, Suite 201 Minden, NV 89423			EXAMINER BRUCKART, BENJAMIN R	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/809,581

**Applicant(s)**

CAMPBELL ET AL.

**Examiner**

BENJAMIN R. BRUCKART

**Art Unit**

2446

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-22, 50-54, 69, 76, 79, 86 and 92-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22, 50-54, 69, 76, 79, 86 and 92-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

#### **Status of claims:**

Claims 18-22, 50-54, 69, 76, 79 and 86, 92-94 are pending in this Office Action.

Claims 18-20, 50-52, 69, 76, 79, 86 are amended.

Claims 92-94 are new.

Claims 1-17, 23-49, 55-68, 70-75, 77-78, 80-85, 87-91 remain cancelled.

### **Response to Arguments**

Applicant's arguments filed 1/22/10 have been fully considered but are found not persuasive. See remarks below.

#### **Applicant's invention as claimed:**

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 93-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 93 recites the limitation "vanity" email address. What exactly qualifies the email address as vain or pertaining to vanity. How is an email address vain? It is unclear and indefinite.

Claim 94 does not narrow claim 93. Claim 93 states the alternate electronic address is an email but claim 94 conflicts with claim 93 and says the email address which is an alternate

electronic address is also a telephone number. This is inconsistent and does not properly narrow claim 93, instead it conflicts with it.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 18-20, 22; 50-52, 54; 69; 76; 79; 86 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al**

Regarding claim 18, the King reference teaches a method for delivering a message to a user with an electronic account (King: pages 1-2, para 18-20; provisional page 1, para 1-2), comprising the steps of:

receiving the message directed to the user with the electronic account (King: pages 1-2, para 18-20; provisional page 1, para 2-3), where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user (King: page 2; para 22-23); and

determining a standardized physical address of the user from the electronic address using an address database (King: page 2, para 22-23); and

linking the standardized physical address to the electronic account (King: page 2, para 21 "the email would still be routed based on the recipient's physical address" and para 30; the electronic account that associated email with the account number, 'his physical address'; provisional page 1);

determining a preferred address of the user, the preferred address being one of the electronic address and the standardized physical address linked to the electronic account (King: Fig. 2, page 1-2, para 18-20; electronic inbox on email server or hard mail; page 3, para 33-34 designates how data is received; provisional page 1, para 2; opt in address); and

delivering the message to the user at the preferred address (King: page 2, para 22-23, 30; provisional ).

Regarding claim 19, the method of claim 18, wherein the preferred address is the electronic address (King: page 2, para 30).

Regarding claim 20, the method of claim 18, wherein the preferred address is the standardized physical address (King: page 2-3, para 31-32).

Regarding claim 22, the method of claim 18, wherein the address database is a United States Postal Service address database (King: page 2, para 22).

Claims 50-52, 54; 69, 76, 79, 86 are rejected for the same rationale as given above.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 21, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al in view of U.S. Patent No. 5,341,505 by Whitehouse.**

Regarding claim 21, the King reference teaches a method for delivering a message to a user with an electronic account.

The King reference does not explicitly state sending back information of a standardized physical address.

However the Whitehouse reference teaches sending back information of a complete physical address (Whitehouse: col. 6, lines 52-58) in order to providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the system of delivering a message as taught by King to include informing the sender of a complete address as taught by Whitehouse in order to remove the last barrier for automation providing quick, easy, and low cost lookup for complete address information (Whitehouse: col. 5, lines 57- col. 6, line 5).

Claims 53 are rejected at the same rationale as above.

**Claims 92-94 rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al in view of U.S. Patent Publication No. 2001/0020242 by Gupta et al.**

Regarding claim 92, the King reference teaches the method of claim 18.

The King reference fails to teach an alternative email address.

However, the Gupta reference teaches linking an alternate electronic address to the electronic account (Gupta: page 5, para 58-59); and

the preferred address may also be determined to be the alternative electronic address linked to the electronic account (Gupta: page 5, para 58-59) in order to delivery content to the user (direct mails or mass emailing; page 5, para 58; page 6, para 77).

It would have been obvious to one of ordinary skill in the art at the time of the invention to create the invention of King to include alternative contact info as shown in Gupta in order to

allow other ways to provide content to a user (direct mails or mass emailing; page 5, para 58; page 6, para 77).

Regarding claim 93, the method in claim 92, wherein: the alternate electronic address is a vanity email address (Gupta: page 5, para 58 "alternate email address").

Regarding claim 94, the method in claim 93 wherein: the alternate electronic address is a telephone number (Gupta: page 5, para 58, "phone number").

### **REMARKS**

The examiner attempted an interview but calls to applicant's representative, Bruce Hayden, went unanswered.

On page 9 of the response, applicant argue the King reference does not qualify as prior art because it relies on provisional date 3/9/2000 even though the instant application relies on priority date of 3/17/00.

It is also crucial to note that applicant's claims are not awarded priority to the claimed provisional 60189983 filed 3/17/00. Limitations in the claims are not anticipated by said provisional and thus are not awarded the automatic date of priority, consistent with applicant's arguments on the top of page 10 of the response, "priority to provisional patent applications are treated as Continuations in Part in reference to the provisional patent applications in terms of their content." For the purposes of future application, if applicant wishes to claim priority to a certain element of the provisional, it is requested they cite the support from the provisional, otherwise it will be examined as not awarded the date of 3/17/00 and will be given the filing date 3/16/01.

The King reference's provisional date still beats the date of the provisional of the instant case, qualifying it as prior art. The King reference filing date also beats applicant's filing date as it was filed 3/9/01.

The examiner maintains that provisional anticipates all the claim language of the pending application. Specifically “receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user’s electronic account and a non-standardized physical address of the user.” See page 1, para 2; e.box links physical address with the electronic account. Page 1, para 3, 5 further reinforce the priority of the electronic account associated with the physical address. The electronic address is shown on page 2, 2nd paragraph. Electronic mail requires an email address for delivery.

On page 11, applicant argues that King converts a non-standardized address to a standardized address “BEFORE” the message is sent. This is reads upon the claim language, as the message is sent in the last step of the limitation “delivering the message to the user at the preferred address.” This limitation is not awarded the priority date from the provisional.

Regarding the 103(a) rejection, applicant asserts there is no reason to believe that if combined with King, the 9 digit zip code would be returned to the sender of a message.

However, that is the entire point of Whitehouse: to show an obvious improvement of King by allowing lookup and completion of an address. The query to complete the 5 digit zip to a 9 digit zip is returned to the user to complete the addressing to the recipient. Applicant does not provide evidence that Whitehouse cannot be used with King.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R. Bruckart whose telephone number is (571) 272-3982. The examiner can normally be reached on 9:00-5:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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